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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,756	07/24/2001	Ahsan I. Raja	1532.1001	2675
21171	7590	06/09/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			NGUYEN, NGA B	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Applicati n No.

09/910,756

Applicant(s)

RAJA, AHSAN I.

Examiner

Nga B. Nguyen

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-- The MAILING DATE f this communication appears on the c ver sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/6/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This Office Action is in response to the communication filed on July 24, 2001, which paper has been placed of record in the file.
2. Claims 1-8 are pending in this application.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on December 6, 2001 and June 18, 2003, are being considered by the examiner.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 3-7 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter, particularly, an abstract idea.

The claims, as presently claimed and best understood were reconsidered in light of the "Examination Guidelines for Computer-Related Inventions" and were found to be non-statutory. Discussion of the analysis of the claims under the guidelines follows.

Claims 3-7 merely manipulate an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to

social sciences, for example) and therefore are found to be non-statutory subject matter.

As to claims 3-7, the claimed invention is not implemented on a specific apparatus; therefore, the invention is not directed to the technological arts. To be statutory, the utility of an invention must be within the technological arts. The definition of "technology" is the "application of science and engineering to the development of machines and procedures in order to enhance or improve human conditions, or at least to improve human efficiency in some respect." (Computer Dictionary 384 (Microsoft Press, 2d ed. 1994)). When one looks to the present specification to determine what the applicant has invented, the invention appears to be a series of steps performed on a computer. It is clear that claims 3-7 are intended to be directed to the abstract method apart from the apparatus for performing the method. Therefore, claims 3-7 are non-statutory, because they are directed solely to an abstract idea without practical application in the technological arts.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Boesch et al (hereinafter Boesch), U.S. Patent No. 5,897,621.

Regarding to claim 1, Boesch discloses an electronic transaction system, comprising:

bearer bond means for providing an online electronic bearer bond having a monetary value (column 4, lines 15-17, electronic cash);

transaction means for performing monetary transactions with said bearer bond means (column 8, lines 12-48, the server 100 performs transactions with electronic cash of different currencies); and

network means for providing user access to said bearer bond means and said transaction means (column 3, lines 55-65-column 4, line 17 and column 9, lines 40-45, network 50 for providing the customer access to the electronic cash and the server 100 to conduct the transaction).

Regarding to claim 2, Boesch discloses an electronic apparatus adapted for exchanging currency over a network comprising:

an electronic document used for performing transactions (column 1, lines 5-15, the customer pays for a product using electronic cash), wherein said transactions contain data information associated with said electronic document (column 7, lines 40-60, the second set of data includes electronic cash in one currency); and

a database processing and storing said data information to perform said transactions over said network (column 4, lines 8-17, a database including customer account in a first currency and merchant account in a second currency).

Regarding to claim 3, Boesch discloses a method for creating a universally accepted form of payment in an electronic transaction, comprising:

selecting an item costing a first value in a first currency (column 7, lines 7-18, the customer pays an amount to the merchant for a selected product using the customer selected currency that is different than the merchant accepted currency);

converting the first value in the first currency into a second value in a second currency (column 8, lines 25-38, the customer selected currency is converted into the merchant accepted currency); and

executing an electronic transaction by using the second value of the second currency as payment for the item (column 8, lines 40-48 and column 14, lines 50-63, the merchant will receive the price in the merchant selected currency).

Regarding to claims 4-6, Boesch discloses wherein a credit card is not used as payment for the item, a bank account is not used as payment for the item, an electronic bearer document is used as payment for the item (column 1, lines 5-15, the electronic cash is used as payment for the item).

Regarding to claim 7, Boesch discloses wherein the first and second currencies are hard currencies (column 4, lines 33-45, e.g. U.S. dollars, French francs).

Regarding to claim 8, Boesch discloses an electronic transaction system, comprising:

an electronic online bearer bond having a monetary value(column 4, lines 15-17, electronic cash) ;

a database for performing monetary transactions with said electronic online bearer bond (column 4, lines 8-17 and column 8, lines 12-48, the server 100 has a database including customer account in a first currency and merchant account in a

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second currency, the server 100 performs transactions with electronic cash of different currencies);

a network for providing user access to said electronic online bearer bond and said database (column 3, lines 55-65-column 4, line 17 and column 9, lines 40-45, network 50 for providing the customer access to the electronic cash stored in customer account that is stored in a database of the server 100, and the server 100 to conducts the transaction).

### ***Conclusion***

8. Claims **1-8** are rejected.

9. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Elgamal (US 6,138,107) discloses a method and apparatus for providing electronic accounts over a public network.

Ishikawa et al (US 6,343,284) disclose the method and system for billing on the Internet in which a terminal makes a request of a content server for a chargeable service by using a prepaid information medium which has predetermined information necessary for transactions, without using a credit card.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (703) 306-2901. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (703) 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-1113.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

C/o Technology Center 3600

Washington, DC 20231

Or faxed to:

(703) 872-9326 (for formal communication intended for entry),

or

(703) 308-3691 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen



May 27, 2004